

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Cropper, Dean E.

Confirmation No.: 3497

Serial No.: 10/796,171

Art Unit: 3743

Filed: March 10, 2004

Examiner: Nicholson, Keri Jessica

For: Knee Orthosis and Orthotic Method

Attorney Docket No.: CRP002

REQUEST FOR CONTINUED EXAMINATION

United States Patent and Trademark Office
EFS Filing, Amendment
Alexandria, VA 22314

Dear Sir:

In response to the Office Action for the above-identified application, dated November 3, 2011, in response to which a Notice of Appeal was filed April 4, 2011 thereby beginning a period for filing an appeal brief hereby extended by five (5) month petition to November 4, 2011, Applicant Requests Continued Examination ("RCE") and entry of the below-indicated remarks into the record.

The requisite fees are submitted herewith. Please however deduct any required deficiency of payment from, or credit any overpayment to, USPTO deposit account no. 504263.

Remarks begin on page 2 of this paper.

REMARKS

In the most recent Office Action the Examiner noted that claims 1-29 and 32-40 were pending. Claims 1, 15, 27, 32, and 40 are independent claims. All of the amended claims conform to United States Patent and Trademark Office rules and do not add new matter to the application.

Applicant submits that none of these claims are either taught or suggested by the prior art. Applicant therefore requests that the Examiner renew examination of, and allow, these claims as amended, which Applicant respectfully submits are in condition for allowance as noted below.

Rejections under 35 U.S.C. § 102

Neither Labour nor Lehman anticipates the claims because they:

- (1) do not necessarily teach at least one of the structural limitations recited within claims 1, 15, 27, 32 or 40, and indeed
- (2) cannot perform these limitations' recited functions.

Claims 1-3, 5-8, 13-17, 19-21, 26-29, 32, 36 and 37 were rejected as being anticipated by United States patent number 4,445,505 ("Labour").

Applicant respectfully submits, however, that the Examiner allow the claims as amended at least for the following reasons:

Labour does not explicitly teach the following illustrative limitations of these claims:

a concentrated, medial and inward traction member that operatively fits over, and provides concentrated, medial and inward pressure against, the patella;

wherein the concentrated, medial and inward traction member provides a compressive force against the patella, thereby increasing the contact surface area between the patellofemoral articular tissue and an associated femoral trochlear groove.

Labour does not inherently teach the structural limitation, "concentrated medial and inward traction member", or its recited function, *i.e.*, in which it "provides concentrated, medial and inward pressure" because these features are not *necessarily* present in Labour. "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. 'The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)." *Manual of Patent Examining Procedure* § 2112, IV, Eight Ed., August 2001, Latest Rev., August 2006 ("M.P.E.P.") (*emphasis added*).

Labour's strap 80 would not be recognized by one having ordinary skill in the art as being a "concentrated, medial and inward traction member[.]" This is illustrated, *e.g.*, by the attached

prior art definition of “traction[.]” which to one having ordinary skill in the art-at-issue at the time of filing meant a “process of drawing or pulling[.]” See *Taber’s Cyclopedic Medical Dictionary*, 1993, edition 17, p. 2021, Clayton L. Thomas, MD., M.P.H., F.A. Davis Company. The same is true regarding Lehman. Neither reference inherently teaches or suggests an “inward traction member” or “inward traction strap.”

Ruling otherwise results from an unreasonably broad reading of the claims. In what the Applicant believes to be the most recent CAFC authority regarding the “broadest reasonable interpretation” standard, the CAFC in *In re Suitco Surface, Inc.*, 603 F.3d 1256, 1258-1261 (Fed. Cir. 2010) overruled a BPAI finding of obviousness regarding so called “intended use” limitations. As background, the patent relates to a flooring surface for use on athletic courts, namely bowling alleys and shuffleboard. Representative claim 4 is in Jepson claim format (with emphasis added):

4. On a floor having a flat top surface and an improved material for finishing the top surface of the floor, the improvement comprising:

at least one elongated sheet including a uniform flexible film of clear plastic material having a thickness between about one mil and about twenty-five mils and

a continuous layer of adhesive material disposed between the top surface of the floor and the flexible film, the adhesive layer releasably adhering the flexible film onto the top surface of the floor.

Briefly, the first applied “Amos” reference teaches “a floor covering pad comprising a plurality of plastic sheets connected together by a plurality of adhesive layers designed to be used right before entry into a clean room or a hospital bay to remove dirt from the shoes or wheels of incoming traffic.” Each of the plurality of sheets is exposed one at a time and allowed to function to remove dirt until the adhesive on the sheet is filled, and then the sheet is removed and the next sheet is exposed and so forth. The second applied “Barrett” reference teaches “the use of a clear plastic film connected to a floor with an adhesive layer” to “temporarily protect a floor during construction.”

During the reexamination, the examiner asserted rejections based on anticipation by these references, and the Board affirmed. The Board construed the two relevant claim terms broadly: the term “material *for finishing the top* surface of a floor” was construed to mean “requiring a material that is structurally suitable for placement on the top surface of a floor.” Thus, any layer placed above a floor fulfilled this requirement, “regardless of whether it was the top or final layer.” Suitco challenged the Board’s decision affirming the asserted rejections based on this construction.

The Federal Circuit’s opinion acknowledged the practice before the Office that claim terms are to be given “their broadest reasonable construction consistent with the specification,” citing *In re ICON Health & Fitness, Inc.*, 496 F.3d 1374, 1379 (Fed. Cir. 2007), saying that its inquiry was thus whether the Board’s construction was “reasonable,” citing *In re Morris*, 127 F.3d 1048, 1055 (Fed. Cir. 1997). Applying these principles, the Court directly held that the Office’s construction of the term “material *for finishing the top* surface of a floor” was unreasonable:

The express language of the claims requires a "material for finishing the top surface of the floor." '514 patent col.7 ll.67-68 (emphases added). A material cannot be finishing any surface unless it is the final layer on that surface. Otherwise, the material would not be "finishing" the surface in any meaningful sense of the word.

The PTO's proffered construction ignores this reality by allowing the finishing material to fall anywhere above the surface being finished regardless of whether it actually "finishes" the surface. Indeed, according to the PTO, the finishing surface need only be "structurally suitable" for placement on the top surface of the floor" -- i.e., several layers can be placed on top of the "finishing" layer. If the PTO's construction were accepted, a prior art reference with carpet on top of wood, on top of tile, on top of concrete, on top of a thin adhesive plastic sheet anticipates the claims in question because an adhesive plastic sheet falls at some point in the chain of layers. This construction does not reasonably reflect the plain language and disclosure of the '514 patent.

One problem, according to the Court, is that the Office has ignored the part of the standard that limits the bounds of what is "reasonable" to what is consistent with the specification: the rubric is not merely that claims must be given "their broadest reasonable construction" but that they be given "their broadest reasonable construction consistent with the specification" (emphasis added). Moreover, claims are to be read "in light of the specification as it would be interpreted by one of ordinary skill in the art," citing *In re Bond*, 910 F.2d 831, 833 (Fed. Cir. 1990).

The CAFC opinion particularly rejects the Office's reliance upon and justification of its construction because the patentee used the term "comprising" in the claim. "The broadest-construction rubric coupled with the term 'comprising' does not give the PTO an unfettered license to interpret claims to embrace anything remotely related to the claimed invention," according to the opinion. Citing *Schriber-Schroth Co. v. Cleveland Trust Co.*, 311 U.S. 211, 217 (1940), the Court held that the Office must always construe claims "in light of the specification and the teachings of the underlying patent [specification]." Here, both the "express language of the claim and the specification" mitigated against the Office's construction, and "require[d] the finishing material to be the top and final layer on the surface being finished." *Id.*

Likewise, it is an unreasonably broad interpretation of "traction" to suggest that Labour or Lehman's passively touching straps would or could have provided a member or strap that affords a concentrated inward "process of drawing or pulling[.]"

As such, Applicant submits that the rejections are traversed with regard to Labour (or Lehman) for all of the independent claims, which have either a concentrated, medial and inward traction member or a concentrated, medial and inward traction strap.

Rejections under 35 U.S.C. § 103

Neither Labour nor Lehman inherently teach the limitations missing from Cawley or Lamping; nor would they have been combined with Cawley or Lamping from the standpoint of one having skill in the art.

Labour in view of Cawley

Claims 4, 9-12, 18, 22-25, 33-35 and 38-40 were rejected as being obvious over Labour in view of United States patent number 6,551,264 (“Cawley”) and/or Lehman.

Claims 9-12, 22-25, 38 and 39 were rejected as being obvious over Lehman in view of Cawley

At least in view of the above-recited reasoning, however, Applicant respectfully submits that all of these claims are in condition for allowance. In short, none of Labour, Lehman or Cawley teaches or suggests, either inherently or explicitly, a concentrated, medial and inward traction member (or a concentrated, medial and inward traction strap), at least one of which is a structural element in independent claims 1, 15, 27, 32 and 40.

Moreover, the art is replete with evidence that teaches away from the use of a concentrated, medial and inward traction member (or a concentrated, medial and inward traction strap). Nearly every, if not every, knee brace in the prior art - in some way, shape, or form - teaches a protective nest or opening about the wearer's patella. Thus, there is insufficient reason stated to use either Labour or Lehman in any combination of references that arrive at the claims at issue. Such a combination has been made through hindsight and despite the abundant overall teachings in the prior art against a brace that leaves an unprotected patella.

Labour or Lehman in view of Lamping

Claim 13 was rejected as being obvious over Labour (or alternately Lehman) in view of United States patent number 6,485,448 (“Lamping”)

At least in view of the above-recited reasoning, however, Applicant respectfully submits that all of these claims are in condition for allowance. In short, none of Labour, Lehman or Lamping teaches or suggests, either inherently or explicitly, a concentrated, medial and inward traction member (or a concentrated, medial and inward traction strap), at least one of which is a structural element in independent claims 1, 15, 27, 32 and 40.

Moreover, the art is replete with evidence that teaches away from the use of a concentrated, medial and inward traction member (or a concentrated, medial and inward traction strap). Nearly every, if not every, knee brace in the prior art - in some way, shape, or form - teaches a protective nest or opening about the wearer's patella. Thus, there is insufficient reason stated to use either Labour or Lehman in any combination of references that arrive at the claims at issue. Such a combination has been made through hindsight and despite the abundant overall teachings in the prior art against a brace that leaves an unprotected patella.

At least for all of the forgoing reasons, Applicant respectfully requests that the examiner reexamine and allow all of claims 1-29 and 32-40.

Respectfully submitted,

Date November 4, 2011

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